

REMARKS

In the Office Action mailed May 13, 2003 the Examiner noted that claims 1-12 were pending, and rejected all claims. Claims 1 and 7 have been amended, new claims 13 and 14 have been added and, thus, in view of the forgoing claims 1-14 remain pending for reconsideration which is requested. No new matter has been added. The Examiner's rejections are traversed below.

On page 2 of the Office Action the Examiner rejected claims 1, 4, 7 and 10 under 35 U.S.C. § 102 as anticipated by Lowen. Page 3 of the Office Action rejects claims 2, 3, 5, 8, 9 and 11 under 35 U.S.C. § 103 over Lowen. On page 4 of the Office Action the Examiner rejected claims 1, 4, 6, 7, 10 and 12 under 35 U.S.C. § 102 as anticipated by Ono '136. Page 6 of the Office Action rejects claims 2, 3, 5, 8, 9 and 11 under 35 U.S.C. § 103 over Ono '136.

First, the Examiner is basing part of the rejection on design choice (see Office Action, page 4). An assertion that the modification or feature is an obvious matter of design choice is an unsupported conclusion and not a valid basis for the rejection of a claim (see In re Garrett, 33 BNA PTCJ 43 (U.S.P.T.O.Bd.App.Nov. 13,1986)). The rejection is traversed and withdrawal is requested on this basis.

The present invention is designed to remove the need for a specialized device, such as an oscilloscope, and a specialist or expert is capable of using the oscilloscope to determine offset, as particularly noted on application pages 1 and 12. The prior art of Lowen and Ono, as acknowledged by the Examiner, uses an oscilloscope for display. The Examiner also acknowledges that the prior art does not teach that which is needed to display an analog signal in digital form (an A/D converter/conversion). The Examiner nevertheless asserts that the present invention that solves the problem of Lowen and Ono is obvious over the prior art. It is submitted that the Examiner is using hindsight in making the rejections in this case. Hindsight cannot be used in determining the issue of obviousness and the reviewer must view the prior art without reading into that art the teachings of the application or patent (see Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 U.S.P.Q. 781(Fed.Cir.1983)). The rejection is traversed and withdrawal is requested on this additional basis.

As noted above, the prior art does not teach or suggest the means necessary to accomplish the invention nor does the prior art provide a suggested change or a motivation for such change or say anything about the desirability of such a change. The prior art must not only suggest the desirability that the teachings of references be combined but must also suggest the

desirability of the modifications in the manner proposed by the Examiner as well as the results to be achieved (see Ex parte Costa, 211 U.S.P.Q. 636(P.O.Bd.App.1978), ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572,221 U.S.P.Q. 929(Fed.Cir.1984), In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125(Fed.Cir.1984), Lear Siegler v. Aeroquip Corp., 733 F.2d 881, 221 U.S.P.Q. 1025(Fed.Cir.1984) and Diversitech v. Century Steps, 850 F.2d 675, 7 U.S.P.Q.2d 1315(Fed.Cir.1988)). The rejection is traversed and withdrawal is requested on this further basis.

Lowen is directed to a force balancing system that includes balancing equations that reduce the shaking of a platform. An oscilloscope is used to visually see the deviations from balance and to visually understand the corrective masses needed to correct the balance. Lowen is focused on vibration reduction and not to adjusting and confirming offsets, etc. as in the present invention.

Ono '136 is directed a linear motor drive system that can use an oscilloscope to display a position output. Ono is focused on controlling a linear motor in a way to prevent tolerance deviations from affecting operation and not to adjusting and confirming offsets, etc. as in the present invention.

The present invention eliminates the need for the specialized device by converting the feedback signals into digital values and processing them for display on a digital display as emphasized in claims 1, 7, 13 and 14. The prior art of Lowen and/or Ono does not teach or suggest such.

In addition, the present invention, as noted above, is designed to automatically determine the offsets, etc. so that the need for the expert is eliminated. This automatic determination feature is emphasized in claims 1, 7, 13 and 14. The prior art of Lowen and/or Ono does not teach or suggest such.

The dependent claims depend from the above-discussed independent claims and are patentable over the prior art for the reasons discussed above. The dependent claims also recite additional features not taught or suggested by the prior art. For example, claims 6 and 12 emphasize accomplishing the goals of the present invention for two phases. The prior art of Lowen and/or Ono does not teach or suggest such. It is submitted that the dependent claims are independently patentable over the prior art.

It is submitted that the present claimed invention patentably distinguishes over

Lowen and/or Ono and withdrawal of the rejection is requested.

It is further that the claims are not taught, disclosed or suggested by the prior art. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

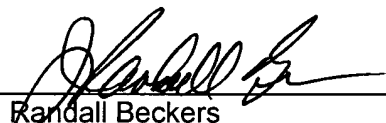
Respectfully submitted,

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8/7/13

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